Supreme Court, U.S.
FILED
OCT 18 1988
JOSEPH F. SPANIOL, JR.
CLERK

No. 88-432

In the
Supreme Court of the United States

OCTOBER TERM, 1988

GABRIEL ELECTRONICS, INC.,
PETITIONER,

v.

ANDREW CORPORATION,
RESPONDENT.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Petitioner's Reply to Respondent's Brief in Opposition

CHARLES E. PFUND*
ROBERT M. ASHER
DIKE, BRONSTEIN, ROBERTS,
CUSHMAN & PFUND
130 Water Street
Boston, Massachusetts 02109
(617) 523-3400
Counsel for Petitioner

*Counsel of Record

BATEMAN & SLADE, INC. BOSTON, MASSACHUSETTS

Table of Contents.

Respondent's cited cases which cite *United Carbon* do not support the Federal Circuit's decision 1

Facts crucial to the indefiniteness issue were set aside with application of the clearly erroneous standard 3

Table of Authorities Cited.

Cases.

Dennison Manufacturing Co. v. Panduit Corp., 475 U.S. 809 (1986) 4

Diamond v. Diehr, 450 U.S. 175 (1981) 3

United Carbon Co. v. Binney & Smith Co., 317 U.S. 228 (1942) 1, 3

Statutes and Rules.

35 U.S.C. § 101 3

35 U.S.C. § 112 3

Federal Rules of Civil Procedure

Rule 52(a) 3

No. 88-432

In the
Supreme Court of the United States

OCTOBER TERM, 1988

GABRIEL ELECTRONICS, INC.,
PETITIONER,

v.

ANDREW CORPORATION,
RESPONDENT.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Petitioner's Reply to Respondent's Brief in Opposition

Respondent's Cited Cases Which Cite *United Carbon* Do Not Support the Federal Circuit's Decision.

The Federal Circuit's departure from the law of this Court as set forth in the *United Carbon Co.* v. *Binney & Smith Co.*, 317 U.S. 228 (1942) is not justified by the cases cited in respondent's opposition.

The present case involves the use of words of degree as the distinguishing patentable feature in patent claims where the improvement begins with advances made in the prior art. The difficulty with the claims of the Knop patent, as found by the district court, is that there is no way of knowing how far down the cone of a horn reflector antenna one may extend absorber without coming within the scope of the patent claims. In the present case, as progressive additions of absorber are made a progressive increase in the taper of the field distribution in the E plane results. This phenomena of an increased taper thus appeared in the prior art and cannot be effectively used to distinguish the invention absent a defined starting point. The Federal Circuit found definiteness at the end point — equality — of E and H plane properties. It did not even consider the starting point in the gap between "equality" and the prior art which the district court said was arbitrary and unforeseeable and as to which the claims gave no clue as to what is intended (App. B, 33a).

Respondent's brief is totally devoid of discussion of the above issue and the cases cited are not in point. This case thus differs significantly from those cases in which words of degree are used in a patent claim to define an element which achieves a function that was not present in the prior art. In such cases, those skilled in the art would be capable of determining those apparatus or methods which come within the scope of the claims, since it would only be those apparatus or methods which achieve the desired functions of the patent. In the present case, the phenomena sought to be achieved by the patent existed, although to a lesser extent, in antennas that were available in the prior art. Hence, function cannot be used to determine the scope of the patent claims. Since the words of degree used in the Knop patent claims fall on a continuum there exists a zone of uncertainty between the prior art and the claimed invention. Such a zone having been strictly forbid-

den by this Court's decision in *United Carbon*, the Federal Circuit's departure from that case law should be reviewed by this Court.

Petitioner strenuously objects to the spurious argument introduced by respondent at page 6 of its Brief in Opposition in an attempt to show that this Court has recently approved words of degree in patent claims, *Diamond* v. *Diehr*, 450 U.S. 175 (1981). In that case this Court was not faced with any Section 112 indefiniteness issue. The only issue discussed in that case was statutory subject matter patentability under 35 U.S.C. § 101. The case has absolutely no relation to the issues of the present case and cannot be useful in harmonizing the Federal Circuit's unprecedented decision in this case with the precedents of this Court.

Facts Crucial to the Indefiniteness Issue Were Set Aside Without Application of the Clearly Erroneous Standard.

Respondent's brief lists a number of issues in which the Federal Circuit referred to the Rule 52(a) clearly erroneous standard as to issues in which it was *affirming* the district court. Notoriously missing from the respondent's list and the Federal Circuit's reference to Rule 52(a) is the one issue, indefiniteness of the claims, where the protections of Rule 52(a) are required. The Federal Circuit failed to heed the requirements of the Rule.

Rule 52(a) requires an appeals court to give deference to the factual findings of the trial court. In order to prevent an appeals court from substituting its own view of the facts, Rule 52(a) requires that fact findings not be set aside unless clearly erroneous. The Federal Circuit was oblivious to this requirement in ruling on indefiniteness under Section 112. Here the

Federal Circuit reversed the trial court holding with respect to indefiniteness without mention or application of the clearly erroneous standard. Rather, the Federal Circuit wrongfully substituted its own view of the facts and approved the zone of uncertainty (i.e., the "gap" App. A., 9a) forbidden by this Court.

Respondent's brief highlighted the importance of factual findings in making a determination of indefiniteness of the claims. As respondent pointed out at page 5 of its brief,

> The differences in the results reached in various cases arise solely from the differences in the facts involved in the respective cases, not from any differences in the law applied.

It is thus clear to both parties that the factual findings underlying a decision of indefiniteness are critical to the final decision. The Federal Circuit's failure to make application of the clearly erroneous standard to the factual findings underlying indefiniteness was critical to its decision in reversing the trial court. This was a clear violation of this Court's mandate in *Dennison Manufacturing Co.* v. *Panduit Corp.*, 475 U.S. 809 (1986) warranting review by this Court.

A writ of certiorari should issue to bring the procedure and decisions of the United States Court of Appeals for the Federal Circuit into compliance with the precedents of this Court.

Respectfully submitted,

CHARLES E. PFUND,*
ROBERT M. ASHER,
DIKE, BRONSTEIN, ROBERTS,
CUSHMAN & PFUND,
130 Water Street,
Boston, Massachusetts 02109.
(617) 523-3400
Counsel for Petitioner

*Counsel of Record